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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK LESTER and SCOTT WILSON

Appeal 2008-1418
Application 10/748,706
Technology Center 3700

Decided: June 17, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-19.¹ We have jurisdiction under 35 U.S.C. § 6(b). Claims 1, 13, and 19 are representative of the claims on appeal, and read as follows:

¹ Claim 20 is also pending, but stands as being objected to (App. Br. 2.)

1. A method for repair of a joint comprising the steps of:
 - removing a portion of a bone having natural soft tissue attached thereto;
 - implanting an implant within the remaining bone leaving an exposed surface of the implant;
 - preparing a surface of the removed portion of bone to provide the surface with a surface feature to mechanically interlock with a complementary feature defined on the exposed surface of the implant; and
 - mechanically engaging the surface feature of the removed portion of bone with the complementary feature of the implant when the implant is within the remaining bone while the natural soft tissue is still attached to the removed portion of bone such that the complementary feature of the implant does not extend completely through the removed portion of bone.
13. An implant for repair of a joint comprising:
 - a stem configured for implantation within a bone of the joint;
 - a head configured to replace a portion of the articulating aspect of the bone; and
 - a body between said head and said stem, said body including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone.
19. A method of implanting a prosthesis comprising:
 - resecting a portion of a bone having natural soft tissue attached thereto;
 - implanting a prosthesis within the remaining bone;
 - shaping the resected portion of bone to provide a bone tissue feature configured to mate with a feature of the implant; and
 - mating the bone tissue feature with the feature of the implant while the natural soft tissue is still attached to the resected portion of bone.

The Examiner relies on the following references:

Lee	3,939,498	Feb. 24, 1976
Galline	4,889,110	Dec. 26, 1989
Harwin	5,163,961	Nov. 17, 1992
Caldarise	6,008,431	Dec. 28, 1999

We affirm-in-part.

DISCUSSION

Claims 1-12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This is a new matter rejection.

According to the Examiner:

Claim 1 has been amended adding, “*the complementary feature of the implant does not extend completely through the removed portion of bone*” which is new matter. Referring to applicant’s figure 6 and specification page 6 which teaches, “*mating feature 25 cut into the bone portion T can extend along the entire cut surface C as represented by the dashed lines in FIG 6*”. The Examiner interprets this as extending completely through the removed portion of bone.

(Ans. 3.)

The burden is on the Examiner to set forth a prima facie case of unpatentability. *See In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996). The disclosure as originally filed need not provide “*in haec verba* support for the claimed subject matter at issue,” rather, the disclosure should convey to one skilled in the art that the inventor had possession of the invention at the time of filing. *Purdue Pharma L.P. v. Faulding Pharmaceutical Co.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citations omitted).

Appellants argue that the description for Figures 6 and 11 support the objected to language (App. Br. 7-8). We agree, and the rejection is reversed.

The Specification teaches in relation to figure 6 that “the mating feature **25** cut into the bone portion **T** *can* extend along the entire cut surface **C**, as represented by the dashed lines in **FIG. 6.**” (Spec. 6 (emphasis added)). Moreover, in describing figure 11, the Specification teaches that “[i]n the *even[t, sic]* that the dovetail cuts along the entire length of the bone

portion” (Spec. 8.) As noted above, *in haec verba* support for the newly added limitation is not required; all that is required is that the disclosure as filed should convey to one skilled in the art that the inventor had possession of the invention at the time of filing. The use of the terms “can” and “in the event” make it clear that the Specification is discussing alternate embodiments. Thus, the Specification supports the Appellants’ position that both the embodiment wherein the complementary feature of the implant does not extend completely through the removed portion of bone and the embodiment wherein the complementary feature of the implant extends completely through the removed portion of bone are supported by the disclosure as filed. The rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph, for new matter, is reversed.

Claims 13, 14, 16, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lee.

According to the Examiner, Lee teaches:

a method for repair of a joint comprising the steps of:
removing a portion of a bone 53 having natural soft tissue attached thereto;
implanting an implant 10 within the remaining bone leaving an exposed surface of the implant;
preparing a surface of the removed portion of bone to provide the surface with a surface feature (bore 54) to mechanically interlock with a complementary feature (member 20) defined on the exposed surface of the implant, and
mechanically engaging the surface feature of the removed portion of bone with the complementary feature of the implant when the implant is within the remaining bone while the natural soft tissue is still attached to the removed portion of bone.

(Ans. 3-4.) The Examiner finds further that “the slot 14 is also interpreted as a ‘mechanical engagement feature.’” (*Id.* at 7). The Examiner notes further that claim 13 is drawn to a device, *i.e.*, the implant, and that the “language regarding the complementary feature formed in the removed portion of bone is merely functional language.” (*Id.*)

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

As to claim 13 (and the claims dependent thereon), Appellants argue that the “slot 14 . . . is not complementary to a feature formed in the removed bone tissue” but “only receives the bolt 20 with an enlarged head.” (App. Br. 14) Thus, Appellants assert, Lee “does not disclose an implant body with a surface that defines a mechanical engagement feature formed in the bone,” and thus cannot anticipate claim 13 (*id.* at 17).

Claim 13 is drawn to an implant and requires: a) a stem configured for implantation within a bone of the joint; b) a head configured to replace a portion of the articulating aspect of the bone; and c) a body between said head and said stem, said body including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone.

Appellants do not dispute that Lee teaches elements (a) and (b), thus the issue is: Does Lee teach a body including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone? We find that Lee does teach that limitation, and the rejection is affirmed.

Figure 1 of Lee is reproduced below:

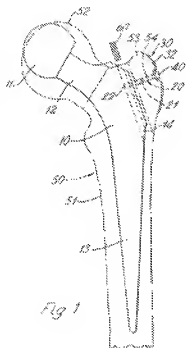


Figure 1 of Lee is drawn to an endoprosthetic femoral head device (col. 1, ll. 7-10, ll. 63-64). In the device of Lee, 14 is drawn to a slot present in the implant (col. 21, ll. 21-22). As taught by Lee, an elongate member 20 is placed through the greater trochanter 53, and an enlarged portion of the elongate member 22 is slidably received from either open end thereof (col. 2, ll. 37-52).

We find that the slot 14 reads on the limitation of claim 13 of “including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone.” Claim 13 is drawn to the implant per se, and Appellants have not provided any scientific reasoning or evidence as to why the greater trochanter 53 could not be configured to engage the slot 14 of the implant.

As to claim 19, Appellants argue that claim 19 is drawn to a method “wherein an implant 1) is implanted into the portion of a bone remaining after another portion has been resected and 2) includes a structure that mates with a feature of a resected bone portion.” (App. Br. 18) According to Appellants, member 20 is implanted in the removed trochanter 53, which is not the portion of the bone remaining after another portion has been resected, as it is the removed portion of the bone (*Id.* at 18-19). Thus, Appellants assert, because “Lee does not disclose an implant with a feature that mates with a bone and that is implanted into a remaining portion of bone as recited in Appellants’ claim 19, Lee does not anticipate Appellants’ claim 19.” (*Id.* at 19.)

Claim 19 requires the steps of: 1) resecting a portion of a bone having natural soft tissue attached thereto; 2) implanting a prosthesis within the remaining bone; 3) shaping the resected portion of bone to provide a bone tissue feature configured to mate with a feature of the implant; and 4) mating the bone tissue feature with the feature of the implant while the natural soft tissue is still attached to the resected portion of bone.

Referring to Figure 1 of Lee, reproduced above, Lee teaches that use of the implant involves exposure of the proximal femur, with the trochanter 53 being detached (Lee, col. 2, ll. 40-43), which reads on step (1) of the method of claim 19. Next, the femoral head 52 is removed, and component 10 is secured to the stem 13 in the medullary canal of shaft 51 (Lee, col. 2, ll. 43-46), which reads on step (2) of claim 19. A bore 54 is then made in the trochanter, and the enlarged portion 22 of the member 20 is placed in

bore 54 of the trochanter (Lee, col. 2, ll. 45-47). We interpret² step (3) of claim 19 to read on adding a bore to the trochanter (shaping the resected portion of the bone) to add a feature (enlarged portion 22) that is “configured to mate with a feature of the implant.” According to Lee, the enlarged portion 22 is placed in the slot 14 (Lee, col. 2, ll. 46-48), which we construe as reading on step (4) of claim 19, *i.e.*, “mating the bone tissue feature [enlarged portion 22] with the feature of the implant [slot 14] while the natural soft tissue is still attached to the resected portion of bone.” Thus, we find that Lee teaches all of the steps of claim 19, and the rejection is affirmed.

Claims 13-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Caldarise.

Caldarise is cited by the Examiner for teaching:

- an implant comprising:
 - A stem 25 configured for implantation in a bone of a joint; and
 - a head configured to replace a portion of the articulating aspect of the bone, said body including a surface 28 defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the

² During prosecution before the Office, claims are to be given their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (2004). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Moreover, it is during prosecution that applicants have “the opportunity to amend the claims to obtain more precise claim coverage.” *American Academy*, 367 F.3d at 1364.

articulating aspect of the bone. Regarding the dovetail, see figure 2.

(Ans. 4-5.)

Appellants argue that claim 13 requires that the body of the implant includes “a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone.” (App. Br. 19.) Appellants argue further that the Examiner does not point out where Caldarise discloses a body between the head and the stem (*id.* at 20), and that the “recesses of Caldarise which the Examiner alleged to be the recited ‘mechanical engagement feature’ were located on the *stem* of an implant, not the *body*” (*id.* at 20-21). Thus, Appellants assert, “because the textured regions 28 are not located between the stem and the head as recited in claim 13, Caldarise cannot anticipate claim 13.” (*Id.* at 21.)

Figure 1 of Caldarise is reproduced below:

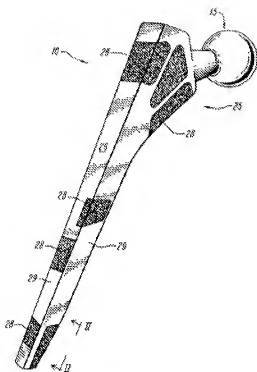


FIG. 1

Figure 1 of Caldarise shows a bone prosthesis (Caldarise, col. 3, ll. 48-49). Roughened portions 28 are provided in the lower stem surface 26, wherein the roughened portion enhance the formation of high-shear strength bone growth (col. 3, l. 67-col. 4, ll. 1-3). Thus, Caldarise teaches an implant comprising: an a stem configured for implantation within a bone of the joint [the portion of the implant in Figure 1 of Caldarise under reference numeral 26]; a head configured to replace a portion of the articulating aspect of the bone [15]; and a body between said head and said stem [the portion of the implant that widens out after the stem above reference numeral 26 and between reference numeral 26 and the head 15], said body including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone [the surfaces 28 above reference numeral 26].” Caldarise thus teaches all of the

limitations of claim 13, and as claims 14 and 15 stand or fall with claim 13 (App. Br. 22), the rejection is affirmed as to all of the claims.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Lee and Harwin and/or Galline.

As Appellants only argue that Harwin and/or Galline do not remedy the deficiencies of Lee (App. Br. 22-23), the rejection is affirmed for the reasons set forth in the analysis of the rejection of claims 13, 14, 16, and 19 under 35 U.S.C. § 102(b) as being anticipated by Lee.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Caldarise and Harwin and/or Galline.

Again, as Appellants only argue that Harwin and/or Galline do not remedy the deficiencies of Caldarise (App. Br. 23), the rejection is affirmed for the reasons set forth in the analysis of the rejection of claims 13-15 under 35 U.S.C. § 102(b) as being anticipated by Caldarise.

CONCLUSION

In summary:

The rejection of claims 1-12 stand under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is reversed;

The rejection of claims 13, 14, 16, and 19 under 35 U.S.C. § 102(b) as being anticipated by Lee is affirmed;

The rejection of claims 13-15 under 35 U.S.C. § 102(b) as being anticipated by Caldarise is affirmed;

The rejection of claims 17 and 18 stand under 35 U.S.C. § 103(a) as being obvious over the combination of Lee and Harwin and/or Galline is affirmed; and

the rejection of claims 17 and 18 stand under 35 U.S.C. § 103(a) as being obvious over the combination of Caldarise and Harwin and/or Galline is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

dm

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